

REMARKS

“*What a long strange trip it has been,*” lyric by musical group The Grateful Dead.

Undersigned registered practitioner wrote the parent applications and prosecuted this one before
5 the Office until May 15, 2002. The present inventor, and now once again the owner of the subject invention, has again retained undersigned to prosecute this application. Provided herewith are:

- (1) A new power of attorney (form PTO/SB/81);
- (2) A petition for a one-month extension of time (per EFS-Web); and
- 10 (2) A Request for Continued Examination (RCE).

The Examiner is thanked for the comments in the Action. They have helped us considerably in understanding the Action and in drafting this Response thereto.

It is our understanding that claims 12-15 and 26-31 remain pending in this application.

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Preliminary item:

Please note that the practitioner docket number for this matter has changed, from M5386-02 to 60843.300101. Entry of the new number into the Office’s databases and use of this new number would be appreciated.

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We proceed now with reference specifically to the numbered items in the Action.

Item 1:

Among other things, this states “*No claim has been amended.*” Respectfully, this is error. Claim 24 was amended by preliminary amendment at the time of filing. This can be seen in the
25 image file wrapper (IFW) as an “*Amendment - After Non-Final rejection*” dated 10-28-1999. IN view of the amendments herein, however, this is moot.

Otherwise, this appears correct and to be informational in nature, and is understood to require no reply.

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Items 2-3 (Drawings 1 of 2):

The Action here states “*The drawings are objected to because figures 1-11 are none [SIC] descriptive. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application.*” Respectfully, this is error.

5 First, “*none descriptive*” is clearly nonsensical. We presume for the sake of discussion here that “*non descriptive*” was meant.

Second, it is not clear from the Action how the drawings can be “*non descriptive*,” since the Action fails to note anything specific about perceived deficiencies in the drawings. This is also odd because the present drawings are the very same as those in the parent PCT application, 10 which was filed in the USPTO acting as a PCT Receiving Office (RO), which was the basis of a prior art search by the USPTO acting as a PCT International Search Authority (ISA), which was the basis of a full and favorable examination by the USPTO acting as a PCT International Preliminary Examination Authority (IPEA), and where there were no objections to the drawings raised during any of this.

15 Accordingly, it appears that this is error or that the Action does not properly communicate the basis for the rejection/objection here such that Applicant is given fair opportunity to reply (MPEP 706.02(j)). Applicant respectfully asks that this objection be withdrawn or to be provided with specific indication what is felt to be wrong with the drawings.

20 **Item 4 (Drawings 2 of 2):**

The Action here states “*the newly submitted drawings on November 14, 2006 are not entered*” Applicant accepts the fact of non-entry. Applicant’s position, discussed above, is that the objection to the original drawings is improper, at least as to procedural sufficiency. In view of this, any argument with respect to the substantive content of the newer drawings is 25 premature.

Items 5-15 (Response to Arguments):

We thank the Examiner for considering the inventor’s prior remarks while proceeding pro se. We trust that the issues noted in these items of the Action will be moot in view of the 30 following.

Items 16-40 (The § 102(e) rejections):

Claims 1-25 (all) are rejected as being anticipated by Subler. With respect to Applicant's initial, broadly drafted claims, we agree with the Examiner's general analysis and we amend the claims as discussed presently.

5 Respectfully, for the record, Applicant does not agree with all of the broad characterizations in the Action of Subler. For example, it deals almost exclusively with distribution via CD-ROM media, which is not a preferred media for initial asset distribution in the present invention. Applicant's preferred media for such distribution is primary mass-storage, e.g., a computer hard drive, with other media, e.g., CD or DVD, used (optionally) for additional 10 and updated asset distribution. We urge that Subler does not teach this, and that such would not be obvious to one of ordinary skill in the art in view of Subler or any other art prior to Applicant's teachings herein, as evidenced by the fact that such simply is not known in all of the years since Subler issued.

15 Applicant cancels claims 1-11 and 16-25, amends claims 12-14 (leaving claim 15 which depends from claim 12 as is), and presents new claims 26-31.

20 Amended claim 12 is independent and is directed to a method for marketing digital content. We urge that claim 12 is particularly distinguishable from Subler because the inventory of assets is stored in a hard drive and this hard drive is installed in a "*personal computer prior to delivery of said personal computer to a user.*" Nothing in Subler teaches or reasonably suggest this.

25 Newly presented claim 26 is independent and is directed to a system (apparatus) for marketing digital content to a user on a personal computer. Here we have "*a hard drive installed in the personal computer*" and "*a logic in the to personal computer*" handling the marketing of assets stored in the hard drive. Again, nothing in Subler teaches or reasonably suggest this.

30 And newly presented claim 29 is independent and is directed to a unit (article of manufacture) for use in marketing digital content to a user of a personal computer. Here we have "*a hard drive for installation into the personal computer*" and "*at least one said asset is an executable software that is pre-configured to run from said hard drive*" (see e.g., pg. 11, ln. 3 "*computer software*"; pg. 2 ln. 12 through pg. 3, ln. 27; and pg. 15, ln. 6-9 "*computer software asset 22 in the inventory*"). Yet again, nothing in Subler teaches or reasonably suggest this.

Items 41-46 (Conclusion):

These appear informational in nature and are understood to require no reply.

CONCLUSION

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Applicant has endeavored to put this case into complete condition for allowance. It is thought that the objections are shown to be unfounded and that the §102 rejections are addressed by amendment or else shown to be unfounded on the prior art references cited. Applicant therefore asks that all objections and rejections now be withdrawn and that allowance of all

10 claims presently in the case be granted.

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Respectfully Submitted,

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